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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

QM02/0420

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ROSS PATENT LAW OFFICE
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DEL MAR CA 92014

PRINER, K
ART UNIT

PAPER NUMBER

3751
DATE MAILED:

04/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/429,939

Applicant(s)
Authier et al.

Examiner
Kathleen J. Prunner

Art Unit
3751



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 2, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on Mar 2, 2001 is: ☒ approved ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

Art Unit: 3751

DETAILED ACTION

Drawings

1. The proposed substitute sheets of drawings submitted March 2, 2001 should have been submitted in a separate paper as required by 37 CFR 1.4(c). The paper has been entered. However, all future correspondence **must** comply with 37 CFR 1.4.
2. The proposed substitute sheets of drawings, filed on March 2, 2001 (as an attachment to Paper No. 7), have been approved.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tompkins et al. ('720) in view of Dundas. Tompkins et al. disclose a freeze control system for a spa having a heating element 26, a pump 24 for pumping water, a sensor 21 for detecting the temperature of the water in the spa, and a computer 10 programmed to process signals and selectively activate and deactivate the heating element 26 and the pump 24 (note from line 66 in col. 18 to line 36 in col. 19). Although Tompkins et al. use water temperature sensor 21 as well as other water sensors to operate the freeze control system, attention is directed to Dundas who discloses another freeze control system for a spa or pool that uses both a water temperature sensor and an ambient air temperature sensor to activate

Art Unit: 3751

the control system (note lines 54-57 in col. 1 and lines 16-33 in col. 2) in order to heat the pool using minimal energy with less waste and expense (note lines 15-19 and 35-37 in col. 1). It would have been obvious to one of ordinary skill in the spa/pool art, at the time the invention was made, to use an ambient air temperature sensor in conjunction with the water temperature sensor in the control system of Tompkins et al. in view of the teachings of Dundas in order to more effectively operate the control system using minimal energy and less waste and expense. With respect to claims 2 and 8, the positioning of the ambient air temperature sensor is considered to be an obvious expedient to the skilled artisan since to obtain an accurate ambient air temperature reading, the ambient air temperature sensor should necessarily be mounted so as to be unaffected by any apparatus that emits heat including that of the components of the control system. With regard to claims 3, 4, 9 and 10, it is considered that to position the ambient air temperature sensor closer to the spa equipment where it can be affected by the heat generated by the operating and control systems of the spa/pool and to have the computer make the required correction factors to account for this heat would be an obvious expedient to the skilled artisan especially when available space is limited and accurate readings are key to the efficient operation of the spa. With regard to claims 6 and 12, although it is considered that the predetermined time period necessary to effect operation of the pump is an obvious expedient to the skilled artisan, to use a predetermined time period of one minute to effect operation of the pump is simply the result of optimization of the prior art teachings through routine experimentation, which is not a matter of invention, absent a showing to the contrary (see *In re Aller*, 220 F.2d 454,

Art Unit: 3751

456, 105 USPQ 233, 235 (CCPA) 1955), and *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969). With respect to claim 7, Tompkins et al. further disclose an air blower 28.

Response to Arguments

5. Applicant's arguments filed March 2, 2001 (Paper No. 7) have been fully considered but they are not deemed persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is found in the references themselves as stated in the above rejection of the claims.

In response to applicant's arguments, the recitation of a spa has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claims does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976); *Kropa v. Robie*, 88 USPQ 478, 481 (CCPA 1951).

In response to applicant's argument that the Dundas reference is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to

Art Unit: 3751

be relied upon as a basis for rejection of the claimed invention. *In re Oeticker*, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). In this case, both the Tompkins et al. and Dundas references relate to the common art of freeze control systems for contained bodies of water. Since applicant is concerned with a freeze control system, it is considered that both the Tompkins et al. and Dundas references are pertinent to the particular problem, i.e., preventing the freezing of a body of water, with which applicant is concerned.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the claims have been amended to include the language "for maintaining the temperature of the water inside the spa and the spa's associated piping above the freezing point", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3751

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final rejection.

7. Any inquiry concerning this communication from the examiner should be directed to Examiner Kathleen J. Prunner whose telephone number is 703-306-9044. The examiner can normally be reached Monday through Friday from 5:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson, can be reached on 703-308-2580. The FAX phone number for the organization where this application is assigned is 703-308-7766.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-0861.



Kathleen J. Prunner:kjp

April 19, 2001

GREGORY L. HUSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

